

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Wang, Eugenia
Re: Application of: Marc Bednarz
Application No. 10/506,386
Filed: 09/02/2004
For: Method for Inerting the Anodes of Fuel
Art Unit: 1795
Confirmation No.: 1647

June 16, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S i r:

REPLY BRIEF

In response to the Examiner's Answer of April 16, 2009, Applicant offers the following additional comments.

In his Answer, the Examiner once again correctly states, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art". However, the Examiner does not provide any basis in fact and/or technical reasoning, other than the conclusory statement that, "D'Alessandro et al.'s method uses

steps employed by the instant application”. Applicant submits that this is hardly a basis in fact and/or technical reasoning.

Furthermore, the Examiner required that Applicant “provide that that (sic) the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product”. Applicant has done this at length in both the responses to the Office Actions and in the Appeal Brief. Applicant directs the Examiner’s attention to the arguments presented on pages 5 – 9 of the Appeal Brief, particular reference being made to the first paragraph on page 8 of the Appeal Brief where it is specifically indicated that D’Alessandro et al. do not necessarily or inherently produce electrolysis. The reason for this is that in D’Alessandro et al. the anode is flushed with only inert gases. If electrolysis were present, a non-inert gas would be present in the vicinity of the anode. Thus, D’Alessandro et al. does not necessarily or inherently carry out the process of the present invention.

As has been previously discussed, the Examiner’s reliance on inherency in rejecting the claims is misplaced. “To establish inherency, the intrinsic evidence ‘must make clear that the missing descriptive manner is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’ . . .’ Inherency, however, cannot be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson* 160F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999).

Even though on the surface there may appear to be similarities between D’Alessandro et al. and the method of the presently-claimed invention, as was set forth by the Supreme Court in *Tilghman v. Proctor*, 102 U.S. 707 (1881), the “accidental and unwitting” production of a certain process does not constitute anticipation. Therefore, even if for argument’s sake D’Alessandro et al.

carry out similar steps to the presently-claimed invention, any electrolysis which might take place (although applicant argues that none takes place) would be accidental and unwitting. "Whilst the operators were in pursuit of other and different results, without exciting intention and without it even being known what was done or how it had been done, it would be absurd to say that this was an anticipation of Tilghman's discovery". 102 U.S. at 711. Similarly, and in the present instance, if by some chance electrolysis did take place to a limited degree in D'Alessandro et al.'s process, there was no recognition of this by D'Alessandro et al. and, in the words of the Supreme Court, "it would be absurd to say that this was an anticipation".

In conclusion, applicants submit that the Examiner's arguments based on inherency are unfounded and D'Alessandro et al. do not in any way disclose the presently-claimed invention.

Fees

No fees are believed to be due. However, if any fee is determined to be due, authorization is hereby given to charge the fee to deposit account #02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this document is being electronically transmitted to the Commissioner for Patents via EFS-Web on June 16, 2009.

LUCAS & MERCANTI, LLP

By: 

Klaus P. Stoffel, Reg. No. 31,668

Respectfully submitted

LUCAS & MERCANTI, LLP

By: 

Klaus P. Stoffel, Reg. No. 31,668

(Attorney for Applicant)

475 Park Avenue South

New York, New York 10016

Tel: (212) 661-8000